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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/091,704 10/13/98 FRANKE

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MERCHANT & GOULD
P O BOX 2903
MINNEAPOLIS MN 55402-0903

EXAMINER

SHEWAREGED, B

ART UNIT

PAPER NUMBER

1774

19

DATE MAILED:

04/10/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/091,704

Applicant(s)
Franke

Examiner
Betelhem Shewareged

Group Art Unit
1774



☒ Responsive to communication(s) filed on Jan 19, 2001

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1, 4-15, 18-26, and 65-68 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1, 4-15, 18-26, and 65-68 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

1. Applicant's response filed 01/19/2001 has been fully considered. However, upon further consideration the Examiner believes that there are two distinct inventions which do not have a single general inventive concept. Therefore, a lack of unity of invention with regard to claims as originally filed exists.

Election/Restrictions

2. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1, 4-14, 65 and 66, drawn to a transfer article.

Group II, claim(s) 15, 18-26, 67 and 68, drawn to method of a transfer article.

3. The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Where a group of inventions is claimed in an

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application, the requirement of unity of invention shall be fulfilled only when there is a *special technical relationship* among those inventions involving one or more of the same or corresponding technical features which define a contribution over the prior art. *See* 37 CFR 1.475. The special technical feature of the present invention--a transfer having a carrier a sheet, a colored pattern on the carrier sheet, a transparent elastomer layer on the colored pattern, and a hot-melt granulate sprinkled on the elastomer later--does not define a contribution over the prior art, as is revealed by Olsen (US 5,916,399) on (abstract; col. 3, line 27 thru col. 4, line 21; col. 5, lines 44-46; and col. 6, lines 35-37). Consequently, a lack of unity of invention exists. *See* 37 CFR 1.475 and MPEP 1850.

4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Any inquiry regarding this communication or earlier communications from the Examiner should be directed to Betelhem Shewareged, whose telephone number is (703) 305-0389. The Examiner can normally be reached Monday to Thursday from 7:30 AM to 6:00 PM.

A facsimile center has been established in Group 1700, Crystal Plaza 3, 8th floor, reception area. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier number for accessing the facsimile machine is (703) 305-3599 (for official after final

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faxes) or (703) 305-5408 (for all other official faxes). This location should be used in all instances when faxing any correspondence to Art Unit 1774. Use of the Group 1700 center will facilitate rapid delivery of materials to Examiners in Art Unit 1774.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0651.



**BRUCE H. HESS
PRIMARY EXAMINER
GROUP 1300**

BS 

April 6, 2001.